



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,520	12/07/2007	Martyn Pritchard	13425-200US1 BV-1093 US	6818
26161 7590 08/05/2010 FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER MCINTOSH III, TRAVISS C	
			ART UNIT 1623	PAPER NUMBER
			NOTIFICATION DATE 08/05/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/598,520	<b>Applicant(s)</b> PRITCHARD ET AL.	
	<b>Examiner</b> TRAVISS C. MCINTOSH III	<b>Art Unit</b> 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 29-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-6 and 29-76 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 1623

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-5, 29, and 58 in part, drawn to compounds of claim 1 subset (I) having  $X=OH$ ;  $R_2=NH_2$ ;  $R_5=CH_2OH$ ;  $R_6=H$ ; and  $R_1$  be one of the various claimed groups, and compositions comprising the same.

Group II, claim(s) 1, 3-5, 29, and 58 in part, drawn to compounds of claim 1 subset (II) having  $X=OH$ ;  $R_1=H$ ;  $R_5=CH_2OH$ ;  $R_6=H$ ; and  $R_2$  being one of the listed groups, and compositions comprising the same.

Group III, claim(s) 1, 3-5, 29, and 58 in part, drawn to compounds of claim 1 subset (III) having  $X=OH$ ;  $R_5=CONHR_3$ ;  $R_6=H$ ; and  $R_1$  and  $R_3$  are one of the listed groups, and compositions comprising the same.

Group IV, claim(s) 1, 3-5, 29, and 58 in part, drawn to compounds of claim 1 subset (IV) having  $X=OH$ ;  $R_1=H$ ;  $R_2=NH_2$ ;  $R_5=CH_2NHCOR_4$ ; and  $R_6$  is one of the listed groups, and compositions comprising the same.

Group V, claim(s) 1, 3-5, 29, and 58 in part, drawn to compounds of claim 1 subset (V) having  $X=OH$ ;  $R_5$  is  $CH_2OH$ ;  $R_6$  is  $H$ ; and  $R_1$  and  $R_2$  are one of the listed groups, and compositions comprising the same.

Group VI, claim(s) 1, 3-5, 29, and 58 in part, drawn to compounds of claim 1 subset (VI) having  $X=OH$ ;  $R_2=NH_2$ ;  $R_5=CH_2OH$ ;  $R_6=$ Methyl; and  $R_1$  is one of the listed groups.

Group VII, claim(s) 6 and 31, drawn to methods of using the compound of formula VII, which is different in scope than any of the claimed compounds from groups I-VI above.

Group VIII, claim(s) 30 and 32-57 in part, drawn to methods of treating various diseases with the compounds of Group I.

Art Unit: 1623

Group IX, claim(s) 30 and 32-57 in part, drawn to methods of treating various diseases with the compounds of Group II.

Group X, claim(s) 30 and 32-57 in part, drawn to methods of treating various diseases with the compounds of Group III.

Group XI, claim(s) 30 and 32-57 in part, drawn to methods of treating various diseases with the compounds of Group IV.

Group XII, claim(s) 30 and 32-57 in part, drawn to methods of treating various diseases with the compounds of Group V.

Group XIII, claim(s) 30 and 32-57 in part, drawn to methods of treating various diseases with the compounds of Group VI.

Group XIV, claim(s) 60-66, drawn to methods of making the compounds of group I.

Group XV, claim(s) 67-68, drawn to methods of making the compounds of group II.

Group XVI, claim(s) 69-71, drawn to methods of making the compounds of group III.

Group XVII, claim(s) 72-73, drawn to methods of making the compounds of group IV.

Group XVIII, claim(s) 74-75, drawn to methods of making the compounds of group V.

Group XIX, claim(s) 76, drawn to methods of making the compounds of group VI.

The groups of inventions listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The core of the compound of claim 1 is not seen to be a contribution over the art as purine compounds are well known (see adenine for example). As such, since the core is not a contribution over the art, unity is broken. As such, the special technical feature of each of the individual groups is seen to be the specific combination of the different variables which are not required for the other groups. For example, Group I requires R<sub>2</sub> to be NH<sub>2</sub>, but this is not required and/or possible as a variable for groups II, III, and V; likewise, group IV, for example, requires R<sub>5</sub> to be CH<sub>2</sub>NHCOR<sub>4</sub>, which is not possible for any of the other groups. Since unity is

Art Unit: 1623

lacking for the compound claims as set forth in groups I-VI, unity is also lacking for the methods of using (Groups VIII-XIII) and methods of making (Groups XIV-XIX) the same. Moreover, the methods of use as in Group VII provides for use of compounds which are divergent in scope than any of the compounds claimed in Groups I-VI.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention or species.

Should applicant traverse on the ground that the inventions have unity of invention (37 CFR 1.475(a)), applicant must provide reasons in support thereof. Applicant may submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. Where such evidence or admission is provided by applicant, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Art Unit: 1623

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double

Art Unit: 1623

patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRAVISS C. MCINTOSH III whose telephone number is (571)272-0657. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Traviss C McIntosh III/  
Primary Examiner, Art Unit 1623  
July 29, 2010